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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,678	04/05/2001	Grant C. Paton	8580.00	3514
26889	7590	12/13/2007	EXAMINER	
MICHAEL CHAN			KESACK, DANIEL	
NCR CORPORATION			ART UNIT	
1700 SOUTH PATTERSON BLVD			PAPER NUMBER	
DAYTON, OH 45479-0001			3691	
			MAIL DATE	DELIVERY MODE
			12/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/826,678

Applicant(s)

PATON, GRANT C.

Examiner

Dan Kesack

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8,10,21-25 and 27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8,10,21-25 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Amendment filed September 29, 2007 has been entered and fully considered.

Claims 1-6, 8, 10, 21-25, 27 are currently pending. The rejections are as stated below.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 8, and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Dickson et al., U.S. Patent No. 6,574,603, as cited in the previous office action.

Newly added claim 27 is also rejected under 35 U.S.C. 102(e) as being anticipated by Dickson et al., U.S. Patent No. 6,574,603.

Claim 27, In addition to the citations provided with respect to claim 1, Dickson describes the intelligent vehicle controller being used in a variety of environments,

Including a fuel dispenser, as well as a different quick service restaurants. These environments will inherently have different interfaces because the transactions being preformed are completely different.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 21-26 rejected under 35 U.S.C. 103(a) as being unpatentable over Dickson et al., in view of DeVries, Jr. et al., U.S. Patent No. 6,547,133, as cited in the previous Office Action.

Claim 25, The newly added limitation of “transferring one or more computer programs from the ATM to the device which programs generate an interface for the user” is taught by Dickson (column 18 lines 15-17, 28-40).

Furthermore, while Dickson and DeVries Jr. fail to teach inserting the card and entering a PIN both in response to a prompt issued by the interface, Official Notice is taken that an ATM machine issuing a prompt for a user to enter a card and to enter a PIN is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the Applicant’s invention to modify the teachings of Dickson and DeVries Jr. to include the prompting because ATMs are designed to be user-friendly, and providing instructions on how to operate the machine increases the usability.

7. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickson et al., in view of DeVries, Jr. et al., as applied to claims 21 and 25 above, and further in view of Ohki et al., U.S. Patent No. 5,952,639, as cited in the previous Office Action.

Response to Arguments

8. Applicant's arguments filed September 29, 2007 have been fully considered but they are not persuasive.

Regarding Applicant's argument that Dickson does not teach the transmission of programs, Examiner respectfully disagrees. Applicant has given the word "program" an overly narrow definition which is not supported by Applicant's specification. The data which is transmitted to the IVC in Dickson instructs the device as to what should be displayed on the interface, and is considered by the Examiner to be a program.

Programs may be anything which instruct a computer and are not limited as Applicant has argued. While some programming languages are processor dependant, some are architecture independent, and will run in a wide variety of environments. This precludes Applicant's argument that "If Dickson were to transfer a 'program,' Dickson would need to know the type of microprocessor running in the IVC" (Applicant's arguments, p10, point 3), as well as the arguments which depend from this argument (points 4 and 5).

Furthermore, Applicant argues that the rejection under 35 U.S.C. 103 is improper because no valid teaching has been given for combining the references, and that the MPEP requires that the teaching be found in the prior art. Examiner respectfully disagrees.

As to the argument that Examiner's rationale does not constitute a reason for combining, Examiner disagrees. The two references are in the same area of endeavor, and, as cited in the previous Office Action, one of ordinary skill in the art would have had reason to combine the features at the time of the Applicant's invention. Dickson and Devries Jr. describe similar devices, used in similar manners. At the time of Applicant's invention, one of ordinary skill in the art in possession of the Dickson

reference, would look to other in-car transaction devices for features which could be added to Dickson to make the system more robust.

Additionally, Examiner notes that the KSR decision forecloses Applicant's argument that a specific teaching is required for a finding of obviousness. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Finally, regarding Applicant's argument that the "consisting essentially of" language distinguishes the claimed invention over the prior art because the combination of references represents an "agglomeration of elements", Examiner disagrees. The MPEP states:

For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., *PPG*, 156 F.3d at 1355, 48 USPQ2d at 1355. If an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. In re De Lajarte, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). (MPEP 2111.03).

The transitional phrase has been given the interpretation equivalent to "comprising", and, without evidence that the additional steps would materially change the characteristics of the applicant's invention, Examiner maintains that the rejection is proper.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

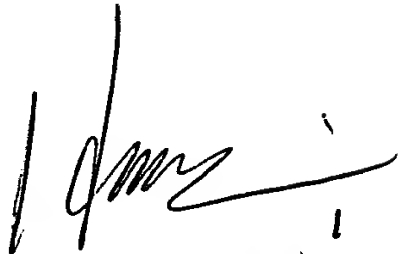
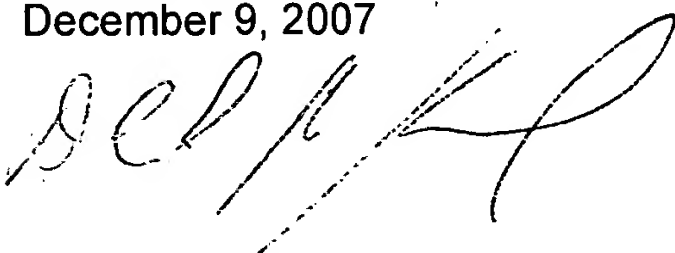
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully Submitted,

Daniel Kesack
Art Unit 3691
December 9, 2007



HANI M. KAZIMI
PRIMARY EXAMINER